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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,128	01/24/2001	Brian B. Cuyler	M 6691 HST CCAE-COIL	5560

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EXAMINER

OLTMANS, ANDREW L

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 06/26/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,128

Applicant(s)

CUYLER ET AL.

Examiner

Andrew L Oltmans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) 23-26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 23-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 21-22 and 27, drawn to a liquid composition of matter, classified in class 148, subclass 243.
- II. Claims 23-26, drawn to an article of manufacture, classified in class 428, subclass 472.3.

The inventions are distinct, each from the other because of the following reasons:

The Group I and Group II inventions are distinct in that they are capable of separate manufacture, use or sale as claimed and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art), MPEP 802.01.

Should applicant traverse on the ground that the inventions are not patentably distinct, the applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. See also MPEP § 818.02(a).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

International Application WO 97/45568 A1

3. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by International Application WO 97/45568 A1 (WO '568; cited on IDS filed July 6, 2001 and the English Language translation cited by Examiner in Paper #6, mailed April 11, 2002).

WO '568 teaches a liquid composition of matter comprising water and dissolved phosphate, zinc and either amino-phenolic polymers (last line or abstract) or polymers of acrylic or methacrylic acid monomers (see English Language translation page 13, lines 8-11) in the claimed concentration and compositional ratio (abstract):

A process for phosphating the surface of steel, galvanised or alloy-galvanised steel, aluminium and/or aluminium-magnesium alloys, in which the phosphating solution contains 0.2 to 3 g/l zinc ions, 3 to 50 g/l phosphate ions calculated as PO₄, 0.001 to 4 g/l manganese ions, 0.001 to 0.5 g/l of one or more polymers selected from among polyethers, polycarboxylates, polymeric phosphonic acids, polymeric phosphino carboxylic acids and nitrogen-containing organic polymers and one or more accelerators. Preferred polymers are amino group-containing poly(vinyl phenol) derivatives.

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(see also English Language translation, page 4, line 26 to page 5, line 15; page 9, line 10 to page 15, line 19 and Examples 1-6). The claims do not distinguish over the teachings of WO '568.

With respect to the limitation "suitable for use as a dry-in-place phosphating composition for galvanized steel", the limitation is merely an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

International Application WO 99/24638 A1

4. Claim 27 is rejected under 35 U.S.C. 102(a) as being anticipated by International Application WO 99/24638 A1 (WO '638 cited on IDS filed July 6, 2001).

WO '638 teaches a liquid composition of matter comprising water and dissolved phosphate, zinc and polymers of acrylic or methacrylic acid monomers in the claimed concentration and compositional ratio (abstract):

(57) Abstract

The invention relates to a method for providing galvanised or alloy galvanised steel strips with corrosion protection, characterised in that the galvanised or alloy galvanised steel strips are brought into contact with an aqueous treatment solution with a pH value of between 1.5 and 3.5, containing 1 to 20 g/l manganese (II) ions and 1 to 150 g/l phosphate ions, and in that the solution is dried without intermediate rinsing. The solution may optionally also contain up to 10 g/l zinc ions, up to 10 g/l nickel ions, up to 20 g/l titanium ions, up to 50 g/l silicon in the form of silicon compounds, up to 30 g/l fluoride ions, up to 150 g/l of one or several polymers or copolymers of polymerisable carboxylic acids chosen from the following: acrylic acid, methacrylic acid, maleic acid and their esters with alcohols with 1 to 6 C-atoms. The invention also relates to metal strips which have been treated in this way.

and (Table 1, page 7):

Tabelle 1: Badzusammensetzungen (g/l in vollentsalztem Wasser)

Komponente	Beisp.1	Beisp.2	Beisp.3	Beisp.4
Mn	3,2	5,4	9	9
Phosphat	6	10	91	91
Zn	-	-	3	3
Ni	-	-	3	3
Ti (als H_2TiF_6)	5	8	-	-
Si (als SiO_2 -Dispersion)	-	-	-	38
Acrylsäure-Polymer	125	75	75	-

The claims do not distinguish over the teachings of WO '638.

With respect to the limitation “suitable for use as a dry-in-place phosphating composition for galvanized steel”, the limitation is merely an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Allowable Subject Matter

5. Claims 21-22 allowed.

Claims 21-22, as amended, are allowable substantially for the reasons set forth on pages 7 and 8 of applicant's response filed May 14, 2003.

Response to Arguments

6. No arguments have been presented with respect to newly presented claim 27 and the claim has been rejected under 35 USC 102 (b), as set forth above.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Oltmans whose telephone number is 703-308-2594. The examiner can normally be reached 7:00-3:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Andrew L. Oltmans

Examiner

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June 24, 2003